

**REMARKS**

The Final Office Action mailed April 20, 2004 has been carefully considered. Claims 1, 3-23, and 35-44 are pending.

The specification has been amended to correct typographical errors directed to a cling property. Applicants submit that suitable materials having an attractive cling property can have a durometer hardness of 10-90 Shore A, as described in The Technology of Plasticizers by J. Kern Sears and Joseph R. Darby, John Wiley and Sons ISBN 0-471-05583-2, pages 305-306.

Applicants apologize for the omission of proposed drawing correction for Fig. 1 in Applicants' response to Communication paper No. 11 and include the proposed formal drawings for correction for Fig. 1 herein.

**Rejection under 35 U.S.C. § 102**

Claims 1, 3-15, 19, 20, 22, 23, 35 and 37-44 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,199,394 to Castelli. The Examiner alleges that Castelli discloses Applicants' present invention and that although Castelli does not disclose a material which provides an attractive cling, the rails of Castelli are formed at plasticized polyvinyl chloride which inherently holds a charge that provides a clinging force. Applicants respectfully traverse.

A 35 U.S.C. § 102(b) rejection is only proper when directed toward an invention that is identically disclosed or identically described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of application for patent in the United States. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single reference." Verdegaal Bros v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Castelli does not disclose the limitation "plastic wrap" as acknowledged by the Examiner on page 5 of Communication paper mailed April 4, 2004. Thus, the present

invention is not anticipated by Castelli because Castelli does not identically disclose or identically describe the invention.

Further, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id.

The Examiner alleges that an attractive cling is provided to the film because the rails are made of plasticized polyvinyl chloride, which inherently holds a charge that provides a clinging force. See page 3 of Communication paper No. 15. Also, the Examiner alleges evidence that polyvinyl chloride provides a charge and a clinging force is shown in sections 16.1-16.4 of Boston University's Physics web page.

Applicants wish to direct the Examiner's attention to sections 16.1-16.4 of Boston University's Physics web page. In these sections, rubber, wood, and plastics (i.e., PVC) are insulators. Insulators, as defined in these sections, have their electrons more tightly bonded to their atoms and are not free to flow. This property inhibits conduction and thus the transfer of electric charge.

However, the sections of the Boston University's Physics web page state that to induce a net charge on an insulator a second material must be rubbed with the insulator (i.e., charging by friction). The example cited in sections 16.1-16.4 is a plastic ruler with a piece of paper towel.

Also, the reference states that these charges are prone to removal, particularly in humid conditions. Further, those skilled in the art would recognize that the net charges

can be removed or neutralized through continuous contact and removal with oppositely charged materials. Therefore, once the net charge is removed from the insulator, particularly the PVC rail of Applicants' invention, the PVC rail will no longer have the "inherent" attractive property to attract the film. To re-establish a net charge, a second material would need to be subsequently rubbed against the rail.

Applicants' invention is not directed to having or needing an induction of a net charge to enable the film to adhere to the base rail nor is the attractive property of the rail removed under humid conditions. As described in the enclosed Declaration of Paul Vegliante, it is known and understood by those skilled in the art that plasticized PVC comprising 10% or more of plasticizers provide an attractive cling property. Cling is defined as follows: In the case of plasticized films, cling and blocking are synonymous. This cling is due to the addition of plasticizer as a result of: (1) smooth surfaces adhere more readily to one another. The addition of plasticizer tends to result in smoother surfaces; (2) plasticizer increases the amorphous content which increases blocking; (3) clean identical flexible PVC surfaces readily wet one another resulting in increased cling; and (4) other secondary mechanisms that increase cling are lowering of the melting point of the resin and increased flow under pressure due to plasticizer addition, as described in The Technology of Plasticizers by J. Kern Sears and Joseph R. Darby, John Wiley and Sons ISBN 0-471-05583-2, page 461. In the case of PVC plasticized films, plasticized PVC having less than 10% plasticizer is a rigid material without plasticization effects of being flexible, as further referenced on enclosed pages 304-307 of the Technology of Plasticizers, J. Kern Sears and Joseph R. Darby, John Wiley and Sons, NY, ISBN 0-471-05583-2. Further, as a result of this percentage of plasticizers, the plasticized PVC is flexible and non-rigid, which is greater than the claimed range of 10% plasticizers. An example of a material having greater than 10% plasticizer is described as Teknor Apex, page 5, lines 19-23 of the present application. As shown on the enclosed data sheet for the Apex material, Apex has a 30% to 35% plasticizer (DEHP).

In contrast, Castelli does not disclose that the tape cutter is flexible, or is formed of plasticized PVC comprising 10% or more plasticizers having a cling property. Rather,

if the tape cutter of Castelli were formed of plasticized PVC comprising 10% or more plasticizers, the plasticized PVC would compromise the structural integrity of the tape cutter because it would be flexible. The flexibility would compromise the tape cutters intended use of being held in a user's hand and securely holding and dispensing several roles of tape. As understood by those skilled in the art, the Castelli device must be formed of material that is rigid. Also, if the tape cutter of Castelli were formed of plasticized PVC having a cling property, the Castelli tape cutter would have the non-desirable property of having material cling to it. Not only would material cling to the base rail for cutting tape, but material would cling to every portion of the tape cutting device of Castelli. Further, Castelli teaches that suitable materials for forming the tape dispenser device are polypropylene, polyethylene and plasticized PVC. However, because polypropylene and polyethylene do not have a cling property, Castelli does not make clear that the "cling" property of plasticized PVC is necessarily present and that any inherent "cling" property of plasticized PVC would be so recognized by persons skilled in the art.

Accordingly, the Examiner has failed to provide objective evidence of cogent technical reasoning to support the conclusion of inherency.

Based on the foregoing, Applicants respectfully request that the 35 U.S.C. § 102(b) rejection with respect to claims 1, 3-15, 19, 20, 22, 23, 35 and 37-44 be reconsidered and withdrawn.

**Rejection under 35 U.S.C. § 103**

Independent claims 1, 20, 22, 23, 35, 37, 38 and 40 and the subsequent dependent claims 3-15, 19, 41-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Castelli in view of U.S. Patent No. 4,787,284 to Chen. The Examiner alleges that Castelli describes Applicants' present invention and that although Castelli does not disclose a material which provides an attractive cling, the rails of Castelli are formed of plasticized polyvinyl chloride which inherently holds a charge that provides a clinging force. Further, the Examiner alleges that although Castelli does not disclose plastic wrap, Chen does and it would have been obvious to provide plastic wrap in Castelli as taught by

Chen in order to dispense a material with different characteristics which can be used to preserve food.

Further, the Examiner alleges "plasticized" means that a material is flexible and that although Castelli does not disclose rails being formed of a material providing an attractive cling to plastic wrap. It is believed that the material in Castelli is the same as the material defined in the claims because Castelli discloses polyethylene, polypropylene, and plasticized polyvinyl chloride. Applicants respectfully traverse.

First, Applicants restate their comments, which are applicable to the obviousness rejection regarding the inherency issue, concerning the Examiner's 35 U.S.C. § 102(b) rejection of the present invention.

Second, Castelli discloses, in column 1, lines 17-35, a tape dispenser for handling several rolls of tape that is made from a single casting or molding operation. The tape dispenser which will hold a plurality of rolls of adhesive tape is adapted to be held in the hand while removing and severing tape sections. Further, Castelli discloses, in column 2, lines 13-35, that body section 15 has raised spacers 19, 20 and 21, all integrally molded therewith. These spacers serve to support a removable spindle 22 and also position the rolls 37 of tape so that sections of tape withdrawn there from can be readily cut. Also, spacers 19 and 21 are spaced respectively from ends 13 and 14 to permit the cutter 21 to travel completely across a withdrawn section of tape. Spacers 19, 20 and 21 also keep the respective adhesive tapes separate from one another.

Those skilled in the art would recognize that to maintain the integrity of the tape dispenser, the tape dispenser would need to be formed of a material sufficiently rigid to support and allow the rolls of adhesive tape to be dispensed while being held in a person's hand and would have a percentage of plasticizer of less than 10%. Furthermore, spacers 19, 20 and 21 need to be sufficiently rigid to allow them to support the removable spindle that is holding a plurality of rolls of tape. Those skilled in the art would recognize that any flexible plastic material would compromise the ability of the Castelli tape dispenser to support the spindle which is weighted down by the plurality of rolls of tape. Also, if spacers 19, 20 and 21 were formed of a flexible plastic, through frequent

use they would bend and in turn compromise and interfere with the turning and dispensing of the tape. Therefore, those skilled in the art would know and understand that a solid, nonflexible and rigid plastic material, such as polypropylene and polyethylene, or plasticized polyvinyl chloride having a degree of plasticization to provide a rigid material would be needed, similar to the plastics conventionally used in tape dispensers to dispense transparent tape.

Furthermore, Castelli teaches that the tape dispenser can be formed of polypropylene and polyethylene. Applicants submit that polypropylene and polyethylene are rigid materials which do not have a cling property. Accordingly, not all the materials described by Castelli could have a cling property and it is not inherent to that the Castelli device would have a cling property, but rather only a possibility. Applicants submit that one of ordinary skill in the art would not recognize which of the materials that are described for making the Castelli tape dispenser could have a cling property.

Thus, Castelli actually teaches away from the use of flexible plastic materials, such as plasticized polyvinyl chloride, and therefore the claims of the present invention are not obvious in view of Castelli. Based on the foregoing Applicants respectfully request that the 35 U.S.C. § 103(a) rejection with respect to claims 1, 3-15, 19, 20, 22, 23, 35, 37-38, and 40-44 be reconsidered and withdrawn.

Dependent claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Castelli in view of U.S. Patent No. 4,202,233 to Larson and unpatentable over the combination of Castelli and Chen in view of Larson. The Examiner alleges that Castelli discloses everything but does not disclose a housing made of acetal. However, Larson does teach a housing made of acetal and would have been obvious to provide a housing made of acetal in Castelli as taught by Larson. Applicants respectfully traverse.

Larson discloses a saw guide device for a hand powered saw. A guide bar extends across a work piece. The material of the base is constructed of a material different from the guide bar pad to reduce sliding friction between the guide bar and the base pad.

In contrast to the invention defined by the present claims, Larson does not teach or suggest rails being formed of a material providing cling properties to plastic wrap received over the rails to hold the plastic wrap before and after cutting of the plastic wrap. Instead, Larson is directed to a tool guide for a saw guide and is unrelated to a film cutter apparatus. Further, there is no teaching or suggestion that a blade for cutting plastic wrap can be formed of acetal. Instead, Larson teaches that an unrelated powered hand saw can be formed of acetal. Accordingly, Larson does not cure the deficiencies of Castelli noted above. In addition, Applicants submit that there is no motivation for one of ordinary skill in the art to combine Larson directed to a saw device with Castelli directed to a tape dispenser and it is only in hindsight that the Examiner can combine these references.

Furthermore, Applicants direct the Examiner to Applicants' remarks regarding the 35 U.S. C. § 103(a) of independent claim 1 upon which claim 16 is dependent from. Upon finding the allowance of independent claim 1, the rejection with respect to dependent claim 16 should be obviated and Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection upon finding claim 1 allowable.

Independent claims 21, 36, and dependent claim 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Castelli in view of U.S. Patent No. 3,552,614 to Wilson and unpatentable over the combination of Castelli and Chen in view of Wilson.

The Examiner alleges that Castelli discloses everything but does not disclose an adhesive layer. However, the Examiner further alleges that Wilson teaches an adhesive layer and that the combination would be obvious to those skilled in the art. Applicants respectfully traverse.

Wilson discloses a protective shield. The shield can be attached to the front wall in any suitable manner. For example, the shield may be stapled, adhesively fastened directly against the front wall.

In contrast to the invention defined by the present claims, Wilson does not teach or suggest at least one rail being formed of a material providing cling properties to the plastic wrap for holding the plastic wrap to the rail during cutting of the plastic wrap.

Accordingly, Wilson does not cure the deficiencies of Castelli noted above. In addition, Applicants submit that there is no motivation for one of ordinary skill in the art to combine Wilson directed to a protective shield with Castelli directed to a tape dispenser and it is only in hindsight that the Examiner can combine these references.

Furthermore, with respect to independent claims 21 and 36, Applicants restate their remarks cited in response to the 35 U.S.C. § 103(a) rejection of independent claims 1, 20, 22, 23, 35, 37, 38 and 40. Also, with respect to dependent claim 17, upon finding independent claim 1 allowable, the rejection with respect to dependent claim 17 should be obviated.

Accordingly, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection with respect to claims 21 and 36 be reconsidered and withdrawn and that the 35 U.S.C. § 103(a) rejection of dependent claim 17 be withdrawn upon the finding of claim 1 allowable.

Dependent claim 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Castelli in view of U.S. Patent No. 3,277,760 to Keene et al. and unpatentable over the combination of Castelli and Chen in view of Keene et al. Applicants respectfully traverse.

Keene et al. teach an apparatus for severing a web. The lower portion of a shuttle is an elongated cylindrical member which may be tapered at either terminal portion to engage insert 46. Means are used to hold the film adjacent to surface 14. (Col. 2, lines 34-37).

In contrast to the invention defined by the present claims, Keen et al. do not teach or suggest at least one rail being formed of a material providing cling properties to the plastic wrap received over the rail for attracting the plastic wrap to the rail and for holding the plastic wrap to the rail during cutting of the plastic wrap. Rather, Keene et al. use means such as rollers to hold the plastic wrap down. Accordingly, Keene et al. do not cure the deficiencies of Castelli noted above.

Applicants direct the Examiner to Applicants' remarks regarding the 35 U.S. C. § 103(a) of independent claim 1 upon which claims 18 and 19 are dependent from. Upon



finding the allowance of independent claim 1, the rejection with respect to dependent claim 16 should be obviated and Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection upon finding claim 1 allowable.


**Conclusion**

In view of the remarks and the amendments, further and favorable consideration of the present application and the allowance of all pending claims are respectfully requested. The Examiner is also invited to contact the undersigned should the Examiner believe that such contact would expedite prosecution of the present application.

It is believed that no fee is required in connection with the filing of the present Amendment. However, if any fee is required, the Commissioner is authorized to charge any such fees or credit any overpayment to Deposit Account No. 13-2165.

Respectfully submitted,

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